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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,913	07/14/2003	Edward Faeldt	9000/2022	7967

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PALMER & DODGE, LLP
KATHLEEN M. WILLIAMS
111 HUNTINGTON AVENUE
BOSTON, MA 02199

EXAMINER

MILLER, MARINA I

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/618,913

Applicant(s)

FAELDT ET AL.

Examiner

Marina Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-36 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, 21-22, and 29-34, drawn to a method for screening for the effect of a test agent on a population of insects, classified in class 702, subclass 19.
- II. Claims 9-19, 21-22, 24-36, drawn to methods for ranking, screening for, and preparing an agent with a desired biological activity, classified in class 435, subclass 6.
- III. Claim 20, drawn to a method for determining parameters useful for a phenoprint, classified in class 435, subclass 6.
- IV. Claims 23 and 25-36, drawn to a method for determining whether an agent modifies, delays or prevents onset of a phenotype in a transgenic insect, classified in class 435, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

The methods of Groups I-IV can be shown to be distinct because they are physically and functionally different, and are not required one for the other. In the instant case of the distinct inventions, each method has a different goal and method steps. For example, a method of Group I is directed to screening for the effect of a test agent on a population of insects comprising steps of providing insects, administering an agent, creating a digital image, correlating the trait with the effect of the agent. Methods of Group II are directed to ranking, screening for, and preparing an agent with a desired biological activity comprising steps of providing insects, contacting the

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population with an agent, determining one trait, ranking/selecting/forming agents. A method of Group III is directed to determining parameters useful for a phenoprint comprising steps of measuring traits in a first and second population, comparing traits and identifying traits. A method of Group IV is directed to determining whether an agent modifies, delays or prevents onset of a phenotype in a transgenic insect comprising steps of providing insects, contacting the population with an agent, comparing agent phenoprofiles, and determining a change. Each method comprises steps requiring manipulations of a sample that is not required for the methods of other Groups.

Because these inventions are distinct for the reasons given above, the classification is different, and the nonpatent and patent literature search required for each group is not coextensive with that requirement for another group, restriction for examination purposes as indicated is proper.

Species Election Requirement

This application contains claims directed to the following patentably distinct species of the claimed invention:

Species A: elect one trait from among those recited, for example, in claims 5, 7, 8, 11, 13, 14, 16, 18, 19, 25, and 27-28.

Species B: elect one measuring data from among those recited, for example, in claims 6, 12, 17, and 26.

Species C: elect one reference population among those recited, for example, in claims 35-36.

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Applicant is required under 35 U.S.C. 121 to elect ONE disclosed species from EACH group A-C for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Currently, claims 1-4, 9-10, 15, 20-24, and 29-34 are generic.

Species of group A, different traits are patentably distinct because traits are structurally and functionally unrelated, and data generated for each trait is expected to be different from data generated by any other type of trite.

Species of group B, measuring data are divergent because they are unrelated, and profiles generated for each measuring data are expected to be different and independent from each other.

Species of group C, different fly reference populations are distinct because each population is structurally and functionally different, and data generated for each population is expected to be different and independent from each other.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

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the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Miller whose telephone number is (571)272-6101. The examiner can normally be reached on 8-5, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, Ph. D., can be reached on (571)272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MARJORIE A. MORAN
PRIMARY EXAMINER

Marjorie A. Moran
9/15/05

Marina Miller
Examiner
Art Unit 1631